



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,238	12/28/2000	Paula Dorf	203-004	8600

7590

07/05/2002

Ward & Olivo  
708 Third Ave  
New York, NY 10017

EXAMINER

COMSTOCK, DAVID C

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 07/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/753,238

Applicant(s)

DORF, PAULA

Examin r

David C. Comstock

Art Unit

3732

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

## **DETAILED ACTION**

### ***Drawings***

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 fails to further limit the subject matter of claim 1 since the "tuft of bristles" recited in claim 1 already necessarily comprises a "plurality of bristles" as recited in claim 2. As such, claim 2 will not be further treated on the merits.

In claim 3, "said root portion" and "said tip portion" each lack a prior antecedent.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application

Art Unit: 3732

published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1, 3, 4, 7, 8, 14, and 16-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Dorf.

Dorf discloses cosmetic brush 93 comprising a tapered handle attached to a ferrule 23 and a tuft 33 of fibrous bristles 25 having a root end and a curved tip end 83. The bristles have varying lengths such that the tuft is thicker at the root end than at the tip end. The handle can be made from a variety of materials including metal or plastic. The ferrule can be made from tin, tin alloy, steel, aluminum, or plastic. The bristles can be formed from synthetic nylon or from hair. (See Fig. 3A; col. 3, lines 39-44 and 57-60; and col. 5, lines 24-34.)

### ***Claim Rejections - 35 USC § 103***

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al. (D258,240) in view of Gueret (5,765,573).

Takada et al. disclose a cosmetic brush comprising a handle attached to an elliptical ferrule and a tuft of fibrous bristles having a root portion and tip portion. Takada et al. do not disclose the tip end of the tuft of bristles being curved. Gueret discloses a similar device having a tuft of bristles 6 with a curved tip 28 to conform to the shape of the user's eye and facilitate the application of eye cosmetics (see Fig. 4b). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the cosmetic brush of Takada et al. with a tuft of bristles

having a curved tip, in view of Gueret, in order to conform to the shape of the user's eye and facilitate the application of eye cosmetics. With regard to claim 3, It would have been further obvious to one having ordinary skill in the art at the time the invention was made to provide the plurality of bristles with varying lengths such that the tuft is thicker at the root, also in view of Gueret, in order to provide a small or pointed brush tip and facilitate the precise application of eye cosmetics (see Gueret, Fig. 7). With regard to claim 7, it would have been an obvious matter of design choice to provide the handle with a taper, since applicant has not disclosed that tapering the handle solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without the handle being tapered. With regard to claims 8-15, it would have also been obvious to one having ordinary skill in the art at the time the invention was made to form the handle from aluminum, steel, tin, tin alloy, wood, plastic, or bamboo, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. With regard to claims 16-21, it would have also been obvious to one having ordinary skill in the art at the time the invention was made to form the ferrule from tin, steel, aluminum, tin alloy, or plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. With regard to claims 23-25, it would have also been obvious to one having ordinary skill in the art at the time the invention was made to form the bristles from synthetic nylon and/or hair, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of

its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 1 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cervantes (4,222,677) in view of Dorf (6,039,051) and Gueret (5,765,573).

Cervantes discloses an eyeliner brush comprising a handle 26 and a tuft 32 of bristles having a root end and a tip end. Cervantes does not disclose the ferrule or the curved tip end. Dorf discloses a similar device 93 having a ferrule 23 to retain a tuft 33 of bristles 25 (see Fig. 3a and col. 3, lines 55-57). Gueret discloses a similar device having a tuft of bristles 6 with a curved tip 28 to conform to the shape of the user's eye and facilitate the application of eye cosmetics (see Fig. 4b). It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the brush of Cervantes using a ferrule to attach the tuft to the handle instead of attaching the bristles directly to the handle in view of Dorf, as such would merely constitute substitution of functionally equivalent means of attaching tufts of bristles to brush handles. It would have been further obvious to one having ordinary skill in the art at the time the invention was made to provide a tuft of bristles having a curved tip, in view of Gueret, in order to conform to the shape of the user's eye and facilitate the application of eye cosmetics. With regard to claim 26, Cervantes discloses a method of applying eyeliner comprising applying eyeliner to the tip end of the brush, positioning the tip end sequentially on a plurality of locations on the lashline, and moving the tip in a back and forth motion on the locations, i.e., "stroking the brush at the desired location" (see Fig. 1; col. 1, lines 10, 19-24, 43-46; and col. 2, lines 20-25 and 30-32).

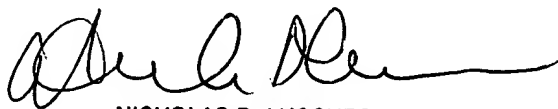
**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.

OC

D.C. Comstock  
June 30, 2002



NICHOLAS D. LUCCHESI  
PRIMARY EXAMINER  
GROUP 3300